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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,358	03/16/2004	Richard Jupe	04981-00493-US	2100
23416 7590 08/31/2007 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			EXAMINER LOPEZ, CARLOS N	
			ART UNIT 1731	PAPER NUMBER
			MAIL DATE 08/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/801,358

**Applicant(s)**

JUPE ET AL.

**Examiner**

/Carlos Lopez/

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/25/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-48 and 50-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44,45,47 and 55 is/are rejected.
- 7) ☒ Claim(s) 46,48,50-54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 IDS</u> | 6) <input type="checkbox"/> Other: _____  |

***Terminal Disclaimer***

The terminal disclaimer filed on 6/25/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,761,174 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44, 45, 47 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. Pat. No. 5,568,819). Gentry discloses a multi-component cigarette filter (30) comprised of a first segment adsorbent section 70 and filter second segment section 72. Section 70 is formed of paper having carbonaceous material or paper (See Col. 4, lines 55ff). Paper is essential a mass of wood fiber as such it is deemed as reading on the claimed limitation of "adsorbent particles" wherein the particles are the actual wood fibers massed to form a paper web that is deemed as the claimed "bed". The word "bed" is merely being interpreted as a heap or agglomeration of mass. However, applicant is invited to provide further structural features that define the claimed "bed."

The second segment as noted in col. 5, lines 25ff is made of filtering material, which Gentry at Col. 10, lines 1ff further teaches of having flavoring agents. Consequently the claimed flavor-releasing component is Gentry's second segment having flavorants.

Hence, the claimed invention is anticipated or alternatively obvious to a person of ordinary skill in the art at the time the invention was made in view of Gentry because a paper web encompasses "bed of adsorbent particles." Applicant may argue that a "bed of adsorbent particles" is not paper, it is noted that paper is a heap or agglomeration of wood fibers that are deemed as an adsorbent to tobacco smoke. Alternatively, the carbon particles in the paper web is deemed as being a "bed of adsorbent particles" since when placed in the filter it forms a heap and/or agglomeration of carbon particles.

The newly filed limitation regarding the ventilation is depicted by element 50 in figure 5 and described in Col. 4, lines 44ff.

As for claim 45, Col. 15, lines 50ff the carbon containing paper is activated carbon which in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having a adsorbent particles including flavorant-bearing activated carbon is arrived.

As for claim 47, second segment 72 is cellulose acetate as noted in Col. 5, lines 35ff in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having cellulose acetate with flavorant thereon is arrived.

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As for claim 55, the amount of carbon claimed is disclosed in Col. 8, lines 1ff of Gentry wherein the claimed filled segments are at least fully filled as shown in the figures of Gentry.

The newly filed limitation regarding the ventilation is depicted by element 50 in figure 5 and described in Col. 4, lines 44ff.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 44 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/346429 ('429) in view of Keitsis (US 5,115,823). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of '429 discloses a cigarette comprising a tobacco rod and a multi-component filter. The filter

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comprises of a bed of sorbent particles and a flavoring releasing component located downstream the sorbent particles wherein the cavity holding the adsorbent particles is at least 85% filled. Claim 2 of '429 further notes of that the sorbent particles are activated carbon. While '429 does not disclose that the activated carbon is adsorbent to mainstream cigarette smoke, it would be obvious to a person of ordinary skill in the art at the time the invention was made that activated carbon are or capable of being adsorbent to mainstream cigarette smoke.

Claim 2 is silent disclosing the use of a ventilation at the upstream portion of the flavor-releasing component that is adjacent to the adsorbent component. However, Keritsis teaches of providing ventilation holes at the upstream portion of a flavorant section/component in order to improve flow characteristic of the smoke being inhaled in so that the smoke can absorb more flavorants (Col. 4, lines 1ff). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have provided ventilation perforations at the upstream section of the flavor component of '429 as taught by Keritsis in order to allow for the smoke being inhaled to absorb more flavorants .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

Claims 46,48, and 50-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 6/25/07 have been fully considered but they are not persuasive. Applicant's argues against the Gentry reference fails to disclose a 85% filled component. However, it is explicitly clear from the figures of Gentry that the cavity holding the adsorbent particles is at least 85% filled.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Carlos Lopez/ whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/  
Primary Examiner  
Art Unit 1731

CL